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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,446	10/20/2003	Karl J. Dobler	200302271-2	3377

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

[REDACTED]
EXAMINER

HANSEN, JAMES ORVILLE

ART UNIT	PAPER NUMBER
	3637

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,446	DOBLER ET AL.	
	Examiner	Art Unit	
	James O. Hansen	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 10, 11, 16, 17 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 10, 11, 16, 17 and 23-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

1. Claims 11, 17 and 27 are objected to because of the following informalities: In Claim 11, it is viewed that the phrase --the rail assembly-- should be inserted before "comprising" since the remaining limitations i.e., rail members, locking mechanism for example, are specific to the "rail assembly" as opposed to the "slide assembly" [both of which are recited in the line preceding the "comprising" term. Appropriate correction is required. In Claims 17 & 27, it is recommended that the term --further-- be inserted before "comprising" since each claim introduces new limitations.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "the second slide rail" & "the first and second rails" do not have a proper antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11 & 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Klakovich [U.S. Patent No. 3,133,768]. Klakovich (figures 1-16) teaches of a track

assembly adapted to be mounted in a rack, the sliding track assembly having a slide assembly (26, 27 e.g.,) mounted to a rail assembly (elements of 22 e.g.,), the rail assembly comprising: first (25) and second (29) rail members engaged with one another expandably, the first and second rail members each having a distal end (inner-most ends) located proximate to the rack; mounting brackets (slotted flanges on each rail member) attached to distal ends of the first and second rail members; and a locking mechanism (44 & 46) interacting with the first and second rail members, the locking mechanism having a locked configuration limiting collapsing movement of the rail members with respect to one another. The locking mechanism is viewed as being “tool-lessly” operable in the sense that the mechanism can be hand tightened.

6. Claims 11, 16, 27-30, 32 & 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Abbott [U.S. Patent No. 6,230,903]. Abbott (figures 1-5) teaches of a track assembly adapted to be mounted in a rack, the sliding track assembly having a slide assembly (21 e.g.,) mounted to a rail assembly (elements of 27, 47 e.g.,), the rail assembly comprising: first (47) and second (27) rail members engaged with one another expandably via the slide assembly, the first and second rail members each having a distal end (inner-most ends) located proximate to the rack; mounting brackets (55, 35 respectively) attached to distal ends of the first and second rail members; and a locking mechanism (29, 31, 49 & 51 for example) interacting with the first and second rail members, the locking mechanism having a locked configuration limiting collapsing movement of the rail members with respect to one another. Each mounting bracket including a mounting tab (37) adapted to be received in a slot in the rack. The assembly further including a biasing member/spring (59) configured to expand the first and second members with respect to one another. The locking

mechanism is viewed as being “tool-lessly” operable in the sense that elements of the mechanism can be hand tightened.

7. Claims 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubbard et al., [U.S. Patent No. 5,586,817]. Hubbard (figures 1-2) teaches of a track assembly comprising: a first rail member (60) configured to receive a second rail member (46) rail expandably, wherein the first and second rail members each include an engaged end (64, 50) located proximate to cooperating portions of the rail members, and a distal end located opposite the engaged end; a biasing member/compression spring (82) configured to bias the distal ends relative to one another; and a locking mechanism (70, 54 for example) configured to prevent relative movement between the distal ends (as viewed when element 70 is at either of the two most extreme positions with element 54). The locking mechanism is viewed as being “tool-lessly” operable in the sense that the mechanism needs no tools to operate. The locking mechanism comprising a tab (viewed as the elongated “tab portion” on end 52) located on the second rail and an actuatable member (70) extending through both rail members for interlocking engagement with the tab via (54).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klakovich in view of Abbott. Klakovich teaches applicants inventive claimed structure

as disclosed above, but does not show the brackets having a mounting tab(s) so as to be received in a slot on the rack. However, Abbott teaches the known use of employing mounting tabs (37) on mounting brackets (35, 55) in an analogous art. As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the brackets of Klakovich so as to incorporate tabs as taught by Abbott because this arrangement would provide Klakovich with a positive seating connection between the brackets and the rails of the rack since the tabs would be "seated" within the mounting apertures as opposed to being loosely aligned and then secured.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 4, 11, 17 and 23-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,702,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements of the presently cited claims are disclosed in the claims of the patented publication.

12. Claims 2, 10 & 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,230,903 in view of Abbott. The '903 publication disclosed applicants claimed structure, but does not specifically claim "mounting tabs" on the brackets or a "slide assembly" in addition to the track assembly. However, Abbott teaches both of these features as previously disclosed. As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the brackets of the '903 publication so as to incorporate tabs and a slide assembly as taught by Abbott because this arrangement would provide '903 with a positive seating connection between the brackets and the rails of the rack since the tabs would be "seated" within the mounting apertures, while the slide assembly would provide a means on the track assembly of '903 for allowing linear movement of a rack component in relation to the rack.

13. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,230,903 in view of Reddicliffe [U.S. Patent No. 6,431,668]. The '903 publication disclosed

applicants claimed structure, but does not specifically claim a "longitudinal slot" on the second rail member so as to be fastened to the first rail member via a fastener. However, Reddicliffe teaches of a first rail member (12) and a second rail member (16) having an elongated slot (18) that accepts a fastener (17) for the purpose of limiting the relative movement of the rail members with respect to each other. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the second rail member of the '903 publication so as to incorporate a slot as taught by Reddicliffe because this arrangement would provide '903 with a means to variably control the depth that the combined rail members produce linearly.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. British publication 1416064, Boulay et al., and Good et al., describe track assemblies within rack systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 703-305-7414. The examiner can normally be reached on Mon.-Fri. 8-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James O. Hansen
Primary Examiner
Art Unit 3637

JOH
July 23, 2004